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In re Application of :
OTTINO et al. :
Application No.: 10/561,202 :
PCT No.: PCT/EP04/51542 :
Int. Filing: 19 July 2004 :
Priority Date: 18 July 2003 :
Attorney Docket No.: 21908-103587 :
For: LOCK FOR A DOOR OF A MOTOR :
VEHICLE :

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' "Petition under 37 CFR 1.47(a)" filed 06 September 2006 to accept the application without the signature of joint inventor, Giacomo Crotti. The \$200 petition fee has been submitted.

BACKGROUND

On 19 July 2004, applicants filed international application PCT/EP04/51542, which claimed a priority date 18 July 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 February 2005. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 18 January 2006.

On 19 December 2005, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and the international search report.

On 31 March 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 06 September 2006, applicants filed the present petition under 37 CFR 1.47(a) and a three-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1),(3) and (4) have been satisfied.

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted.

Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

A review of the present petition reveals that petitioner has not satisfied item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers to Giacomo Crotti. Petitioner has provided a copy of the cover letter addressed to Giacomo Crotti mailed 16 June 2006. However, it is unclear as to the delivery status of the letter. Was the letter(s) returned as undeliverable? Was the letter received by Giacomo Crotti or by someone at the last known address? Further, were any other attempts made to locate Giacomo Crotti? The single mailing of the papers to the non-signing inventor's last known address does not constitute a "diligent" effort to locate the inventor. Applicant must show that alternative means were employed, such as a search of telephone and/or Internet directories, in an attempt to locate Mr. Giacomo Crotti. Additionally, the statements made with regards to the efforts to reach Giacomo Crotti constitutes secondhand knowledge, in that, the actions to which petitioner is averring to were conducted by Alex Porat

Application No.: 10/561,202

For the above reasons, it would not be appropriate to accept this application without the signature of Giacomo Crotti at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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